

REMARKS

Applicant has carefully considered the Examiner's Office Action and has amended the claims to define the invention in clearer form and to distinguish patentably from the prior art.

Thus, applicant has replaced claims 1 to 7 by claims 8 to 14 which include the subject matter and limitations that are not to be found in the prior art.

At the same time, applicant has also amended the specification to provide for the required section headings and to avoid reference to specific claim numbers.

In considering the reference patent 6,918,473 to Deferme that has been applied by the Examiner, it may be seen that the piston 116 is not an annular piston as provided in applicant's invention.

The limitation in applicant's base claim that the vibration-compensating piston is an annular piston is not present in this reference patent to Deferme.

Furthermore, this reference patent to Deferme also does not anticipate the limitation in applicant's base claim, that the inner surface of the annular piston 11 moves against a section of the piston rod. This feature and limitation is not to be found in this reference patent.

In the reference patent to Petrak (3,896,908) which has been applied by the Examiner, the ring member 120 is not hydraulically in parallel with the piston of the vibration damper. Instead, the ring member 120 is within the cylindrical wall 88 and forms the single damping element of the vibration damper.

Accordingly, there are no two independent of each other, damping pistons in this reference patent to Petrak, as are provided by applicant's invention.

In applicant's invention, there is provided a damping piston 3 which assumes the function of the shock absorbing

piston of the vibration damper. Hydraulically parallel to this piston 3 in applicant's invention, the annular piston 11 serves that the vibrations with low amplitudes are dampened, without the effect or operation of the piston 3. This is entirely different in the reference patent to Petrak.

Thus, in this reference to Petrak, a single piston arrangement 34 is provided, through which the damping is achieved by the ring member 120 that operates with a flow-through channel that forms the grooves 136, 138, the bypass opening 134 and the openings or orifices 116.

As a result, the vibration damper of the reference patent to Petrak is entirely different from applicant's invention, as described in applicant's specification and in applicant's claims.

The combination of the reference patent to Deferme as well as the patent to Petrak also differs materially from applicant's invention thereby, since the structural combination of the elements recited in applicant's base claim 8 can provide for amplitudes selection in its damping function, that is not possible with the combination of these two references.

A person working in the art, would therefore not refer to a combination of the reference patents to Deferme and Petrak for the purpose of arriving at applicant's invention.

Even when one has the reference patent to Deferme before him, and considers the possibility from the reference patent to Petrak, that a piston can be formed as a ring-member which rests with its inner surface on a section of the piston rod, then such a combination will not lead to the features and subject matter of applicant's invention.

Even when a person skilled in the art considers the piston 116 which has pins 128, 140 against a ring piston in the sense disclosed in the reference patent to Petrak, for the purpose of exchanging, then the ring piston would not with its inner surface rest against a section of the piston rod. Thus, in the

reference patent to Deferme, the piston 116 is located below the piston rod 34. There is no possibility to exchange the piston 116 in the patent to Deferme with a ring piston for the purpose of arriving at applicant's invention.

In order to provide the piston 116 in the reference patent to Petrak, as defined in applicant's base claim 8, it would be necessary to omit the entire arrangement of the housing 96 with the valve plates 120, 130 and the piston 116 with its pins 128, 140, and construct entirely differently the piston for damping smaller amplitudes. A person working in the art could not derive any inspiration for doing such an entirely different construction. Even with the disclosure in the reference patent to Petrak. This is particularly the case because the reference patent to Petrak does not at all concern itself with the objects of applicant's invention, and correspondingly also not with two hydraulically arranged pistons in parallel with each other.

For proper functioning of the piston arrangement 66 or 98 according to the reference patent to Deferme, the cooperation of the valve plates 120 and 130 with the pins 128 and 140 is of significant importance. Without such cooperation of the valve plates 120, 130 with the pins 128, 140 of the piston 116, the vibration damper of the patent to Deferme cannot carry out its function. The person skilled in the art who recognizes this and this fact clearly, would never consider to construct the piston 116 as a ring piston, because he would have to depart entirely from the construction concept and to design in an entirely different construction. For this purpose, the reference patent to Petrak offers no help whatsoever, because in the patent to Petrak there are no two pistons arranged hydraulically parallel with respect to each other, and there is also no description of any selective amplitude damping as can be achieved with applicant's invention.

Applicant notes that in the corresponding German application, the base claim that was allowed is precisely the

same as the base claim 1 (now claim 8) of the present application. This is demonstrated by claim 1 of the corresponding German Patent in comparison with claim 1 of the present application. During the prosecution of this German Patent, a reference similar to the patent to Petrak, was applied, but the base claim 1 in this German patent was nevertheless allowed. Applicant is submitting a copy of these references in the German language, only for placing them of record in the present application.

It is submitted that applicant provides for a new and marked improvement over the prior art.

Since the claims in the application define clearly the differences between applicant's invention and the prior art, it is believed that the claims should be found allowable.

The Examiner's attention is respectfully directed to the court decision in the case of *In re Bisley* (94 U.S.P.Q. 80, 86), in which the Court ruled that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

In the case of *ex parte Chicago Rawhide Manufacturing Company* (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of